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McDonnell Boehnen Hulbert & Berghoff  
300 South Wacker Drive  
Chicago, Illinois 60606

MAR 09 2006

**OFFICE OF PETITIONS**

In re Application of  
Rodgers et al  
Application No. 09/772,819  
Filed: January 30, 2001  
Attorney Docket No. 98,365-B1

DECISION DISMISSING LETTER

This decision is in response to applicants' "APPLICANT'S COMMENT ON PATENT TERM ADJUSTMENT CALCULATION AND FILING OF TERMINAL DISCLAIMER" filed on July 15, 2005 requesting that the Office review the Patent Term Adjustment at the time of the issuance of the patent. Applicants' assert that the PTA determination may be inaccurate because the Office did not take into consideration the filing of a terminal disclaimer.

The applicants' Application for Patent Term Adjustment is **Dismissed**. The correct determination at the time of the issuance of the application is four hundred and eighty-two days.

Applicants' assert that the patent term determination is incorrect because the applicants filed a terminal disclaimer in the application to obviate a double patenting rejection.

The applicants' arguments are not persuasive. The Office notes that it will make a PTA determination regardless of whether the application has filed a terminal disclaimer. The Office notes that the language of the front of the patent says the following : subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154 (b) by XXX days. Accordingly, it is incumbent upon application to ascertain whether or not the additional time accrued for PTA can be enforced. Accordingly, applicant must review the language of the terminal disclaimer as well as the expiration date of the other patent to determine the expiration date of 09/772,819. See MPEP 2701 (2700-2).

A \$200.00 fee has not been assessed in this application and no additional fees are required by the Office. The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

After the mailing of this decision, this patented application should be forwarded to the file repository for storage of the patented file.

Any additional questions should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration at 571-272-7757.

*Kery Fries*

Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
For Patent Examinationn Policy



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 98,365-B1)

In the application of:

Kathleen E. Rodgers, et al. ) Art Unit: 1654  
Serial No: 09/772,819 ) Examiner: Audet  
Filed: January 30, 2001 ) Confirmation: 3008  
For: Methods for Accelerating Bone, )  
Cartilage and Connective )  
Tissue Growth )

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APPLICANT'S COMMENT ON PATENT TERM ADJUSTMENT CALCULATION  
AND FILING OF TERMINAL DISCLAIMER

Dear Sir:

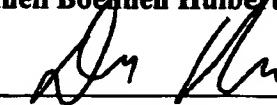
Applicants wish to make the following of record in the above identified patent application:

- 1) Applicants are in agreement with the calculation of the Office, noted in the Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) mailed October 6, 2004, that the Patent Term Adjustment to date is 482 days.
- 2) Applicants note that a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent has been filed in this application, which may alter the applicability of the Patent Term Adjustment.

Respectfully submitted,  
McDonnell Boehnen Hulbert & Berghoff LLP

Date: 7-15-05

By:

  
David S. Harper  
Registration No. 42,636



07-18-25

petition office 7AUV  
PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(MBHB Case No. 98,365-B1)

In re Application of:

Kathleen E. Rodgers, et al. )  
772 ) Group Art Unit: 1654  
Serial No.: 09/722,819 )  
Filed: January 30, 2001 ) Examiner: Audet  
For: Methods for Accelerating Bone, Cartilage ) Confirmation No.: 3008  
and Connective Tissue Growth )

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JUL 25 2005

OFFICE OF PETITIONS

Sir:

In regard to the above identified application,

1. We are transmitting herewith the attached:

Applicant's Comment of Patent Term Adjustment Calculation and Filing of Terminal Disclaimer (1 sheet);  
 Return Receipt Postcard.

2. With respect to additional fees:

No fee is required.  
 Please charge any additional fees or credit overpayment to Deposit Account No.13-2490.

3. CERTIFICATE OF MAILING UNDER 37 CFR § 1.10: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as "Express Mail Post Office to Addressee," mail in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15<sup>th</sup> day of July, 2005 under Express Mail Certificate No. EV722672722US.

Respectfully submitted,

By:   
David S. Harper  
Registration No. 42,636 OIPE/IAP

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AUG 15 2005

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